

REMARKS/ARGUMENTS

Claims 1-6, 8, 11-16, and 18 stand rejected under 35 U.S.C. 102(b) as being anticipated by Melcer; claims 7, 9, 10, 17, 19, and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Melcer.

The examiner is reminded that the standard for inherency as outlined by the Fed. Cir. In Continental Can Company USA, Inc, 948 F.2d 1264 (Fed. Cir. 1991) is as follows:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill.

Claim 1 of the instant invention comprises the limitations of a pump delivering a slurry to a polishing pad; and a rotation sensing device coupled to the pump sensing a rotation of the pump and generating a signal indicative of the rotation of the pump. The Melcer reference cited by the examiner does not disclose the above described limitations. The Melcer reference describes in col. 4, lines 9-17, a pump controller that includes a computer which accepts operator input regarding the desired slurry flow rate, accepts the signal from the slurry inlet pressure sensor, and computes the required pump RPM. The controller then controls the pump to maintain this speed. Inlet pressure is monitored periodically and adjustments to pump speed are made periodically. The pump speed is measured through the motor encoder, and the controller adjusts the control signals to maintain the calculated pump speed. The Melcer reference does not describe a rotation sensing device that generates a signal indicative of the pump rotation. The Melcer reference describes a motor encoder used to monitor the pump speed. The limitations of claim 1 are not disclosed in the Melcer reference and claim 1 is allowable over the Melcer reference under 35 U.S.C. 102(b).

In forming the rejection of claim 1 over the Melcer reference, the examiner states that the limitations of claim 1 are inherent in the Melcer reference. The current standard for inherency is that the thing that is missing must necessarily be present in the reference. For inherency to apply in the present case, it must be shown that the rotation sensing device and signal indicative of pump rotation in the claim 1 must necessarily be present in the Melcer reference. This is clearly not the case. Any number of different sensors and signals can be used and measured. There is nothing to suggest that every pump in the described systems must necessarily comprise a rotation sensing device and signal indicative of pump rotation. The fact that such a device is missing from the Melcer reference is *prima facie* evidence that these features are not inherent. The rotation sensing device and signal indicative of pump rotation is not inherent in the Melcer reference and claim 1 is allowable over the Melcer reference under 35 U.S.C. 102(b) and the theory of inherency. Claims 2-10 depend on claim 1 and therefore contain all the limitations of claim 1. Claims 2-10 are therefore also allowable over the cited references. Independent claim 11 also comprises the limitation of a rotation sensing device and signal indicative of pump rotation and is also allowable over the cited art. Claims 12-13 depend on claim 11 and are also allowable over the cited art.

Independent claim 14 is a method claim comprising the limitations of sensing a rotation of the pump and generating a signal indicative of the rotation of the pump. As described above, the Melcer patent describes measuring the pump speed which is the revolutions per minute (RPM) as opposed to whether the pump is rotating. The limitations of claim 14 are not described in the Melcer reference and claim 14 is allowable over the cited art. Claims 15-20 depend on claim 14 and are therefore also allowable over the cited art.

In light of the above, it is respectfully submitted that the present application is in condition for allowance, and notice to that effect is respectfully requested.

While it is believed that the instant response places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner contact the undersigned in order to expeditiously resolve any outstanding issues.

To the extent necessary, Applicants petition for an Extension of Time under 37 CFR 1.136. Please charge any fees in connection with the filing of this paper, including extension of time fees, to the deposit account of Texas Instruments Incorporated, Account No. 20-0668.

Respectfully submitted,

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Amendments to the Drawings:

None